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\*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Board of Patent Appeals and Interferences

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Appeal No. 95-2910

Application 08/084,337 [FN1]

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

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Before JERRY SMITH, FLEMING and TORCZON

Administrative Patent Judges.

JERRY SMITH

Administrative Patent Judge.

ON BRIEF

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 3-12, 14-21 and 26-47, which constitute all the claims remaining in the application. An amendment after final rejection was filed on June 15, 1994 but was denied entry by the examiner. A second amendment after final rejection was filed on June 29, 1994 and was entered by the examiner.

The invention pertains to a method and apparatus for reducing track-switch latency between data transfer operations on a present track and a new track in a disk drive system. Specifically, the time it will take to begin movement of the active head, or leadoff time, is compared to the time it will take to finish the current read or write operation on the active track. Based upon this comparison, it is determined whether preprocessing operations for moving the head should be implemented.

Representative claim 1 is reproduced as follows:

1. Method for reducing track-switch latency between data transfer operations on a present track and a new track in a disk drive when said present track and said new track are operated on by a currently active head for said present track and a next selected head for a new track, said active and next heads being mounted on a single head arm actuator, said method comprising the steps of:  
determining time remaining for said active head to reach end of track at said present track;  
determining a leadoff interval necessary to complete a pre track-switch processing step and a head arm actuator energizing step;  
detecting when said leadoff interval is greater than said time remaining to said end of track;

performing pre track-switch processing in response to said detecting step; and energizing said head arm actuator in response to said detecting step to build energy in said head arm actuator during said leadoff interval whereby said currently active head completes data transfer at said present track prior to movement of said active head off said present track.

The examiner relies on no references.

Claims 1, 3-12, 14-21 and 26-47 stand rejected under 35 U.S.C. § 112, first paragraph, as being inadequately disclosed. Specifically, the rejection is based on the position that the originally filed specification does not support the invention now being claimed.

\*2 Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the reasons relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us and the level of skill in the particular art, that the reasons advanced by the examiner are insufficient to support the rejection of the claims under 35 U.S.C. § 112, first paragraph, and we will not sustain the rejection.

The relevant facts in this case are not in dispute. The invention relates to the implementation of preprocessing operations in moving a magnetic head from a currently active track to a new track. The preprocessing operations are based on a relationship between a leadoff time to move the head and the time necessary to complete processing on the current track. The originally filed application indicated that preprocessing was done when the leadoff time was less than the processing time [FIG. 8A, elements 56, 58 and 60, and page 13, lines 9-12]. Appellants subsequently amended the drawing and the specification to change the "less than" relationship to read "equal to or greater than" which is the exact opposite of the original recitation. The claims were also amended to recite this relationship. The examiner made a new matter objection to this change and also asserted that there was no support for what to do when the compared values were equal. To eliminate this latter point of contention, appellants amended the phrase "equal to or greater than" to simply read "greater than." The examiner still objected to this phrase as not being supported by the original application, and therefore, directed to new matter. This appeal followed.

A rejection under the first paragraph of 35 U.S.C. § 112 based on the insertion of "new matter" into the application is a rejection based on the written description requirement of Section 112. The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity to those skilled in the art that they were in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. Once the examiner points out that the claimed embodiment is outside the scope of the specification description, the examiner has satisfied his burden of proof. Then the burden of proof shifts to the applicant to show that the claimed invention is part

of the description. In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

\*3 The examiner has taken a position that the originally filed application supports an invention which is separate and apart from the invention now being claimed. In other words, although the examiner admits that the amendments made by appellants support an invention, the examiner is of the view that the originally filed application supported a completely different invention and not the currently claimed one. Appellants argue that the originally filed application supports their position that the "less than" recitation in the original application was inadvertently reversed from what was intended, and the skilled artisan would have recognized this error.

Although the examiner has attempted to demonstrate that the original application can reasonably be interpreted to support a different invention, it is clear to us that the examiner's interpretation is contrary to much of what is described in the disclosure. The examiner's interpretation would have the magnetic head move to another track before operations on the current track have been completed although the original specification says many times that processing on the current track is to be completed before the head is moved to a new track [see, for example, the paragraphs bridging pages 11 and 12 and pages 13-14]. Thus, the examiner's interpretation is contrary to one of the main functions that the disclosed invention is designed to carry out.

Additionally, we agree with appellants that original claim 1 clearly supports the amendments made to the disclosure and claims in this application. The original claim 1 recited the step of "anticipating completion of data transfer at the present track and defining a leadoff interval sufficient for such data transfer to complete." This recitation is equivalent to stating that the leadoff interval must be greater than the time for the data transfer to complete. The next step of original claim 1 recited that preprocessing occurred during the leadoff interval. Since the leadoff interval had to be greater than the time to complete processing, original claim 1 recited that preprocessing occurred only when the leadoff interval was greater than the time to complete processing. The amendments to FIG. 8A and the specification are in accord with the operation of the invention as recited in original claim 1.

Since the originally filed claims are part of the original application, and since we find that the objected to amendments are supported by the originally filed claims, the examiner's rejection of the claims as being unsupported by the original application is in error. Appellants have demonstrated that the invention now being claimed is supported by the originally filed application. Therefore, we do not sustain the rejection of the claims under the first paragraph of Section 112.

The decision of the examiner rejecting claims 1, 3-12, 14-21 and 26-47 is reversed.

REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

\*4 JERRY SMITH

Administrative Patent Judge

MICHAEL R. FLEMING

Administrative Patent Judge

RICHARD TORCZON

Administrative Patent Judge

FN1. Application for patent filed June 28, 1993. According to the appellants, this application is a continuation of Application 07/786,475, filed November 1, 1991, now abandoned.

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